

REMARKS

Applicants thank the Examiner for total consideration given the present application. Claims 1-19 are currently pending of which claims 1 and 18 are independent. Claims 1 and 11-17 have been amended through this Reply. Applicants respectfully request reconsideration of the rejected claims in light of the remarks presented herein, and earnestly seek timely allowance of all pending claims.

SCOPE OF CLAIMS NOT NARROWED

Claims have been amended merely to address informal issues and to enhance clarity. It is intended that the scope of the claims remain substantially the same. Applicants respectfully submit that the amendments made to the claims do not add any new matter to the application and they are not narrowing, and are not made for a reason relating to patentability. Accordingly, it is submitted that these amendments do not give rise to estoppel and, in future analysis, claims 1 and 11-17 are entitled to their full range of equivalents.

OBJECTION TO THE CLAIMS

Claims 11-17 are objected to as allegedly being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. *See Office Action, item 3.* Claims 11-17 have been amended to address this objection. Applicants respectfully request that the objection to the claims be withdrawn.

35 U.S.C. § 103 REJECTION – Hussmann, Ritter

Claims 1-10, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hussmann (U.S. Pub. No. 2003/0218532 A1)(hereinafter “*Hussmann*”) in view of Ritter (CA 2,293,393) (hereinafter “*Ritter*”). Applicants respectfully traverse.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d

488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

In this instance, it is respectfully submitted that neither *Hussmann* nor *Ritter*, alone or in combination, teaches or suggests all claim limitations.

For example, independent claims 1 and 18 recite that the wireless communication device is connected to *an antenna included in said subscriber identity module*. (*Emphasis added.*)

The Examiner acknowledges that *Hussmann* fails to teach or suggest that the wireless communication device is operatively controllable by said processing device and arranged to be operatively enabled or disabled, controlled by a signal provided by the mobile communication terminal via said I/O device. Thus, the Examiner imports *Ritter* to fulfill the above-noted deficiency of *Hussmann*. Although Applicants do not necessarily agree with the Examiner that *Ritter* fulfills the above-acknowledged deficiency of *Hussmann*, it is respectfully submitted that neither *Hussmann* nor *Ritter*, alone or in combination, teaches or suggests a wireless communication device that is connected to an *antenna included in a subscriber identity module* as recited in claims 1 and 18.

Hussmann is directed to a conventional portable, electronic device having a transponder with a memory unit and means for writing user-specific information into the transponder memory, so that the transponder, upon receipt of an interrogating signal, generates a response signal comprising the user-specific information. *Hussmann* is also directed to a method for use

in an interrogating apparatus, so as to authenticate a user carrying such a device, and to a system for authenticating a user carrying such a device. (*See paragraph [0002].*)

As illustrated in Fig. 1, *Hussmann* discloses a general concept of RFID (radio frequency identification) transponders. In the system described with reference to Fig 1, there is no indication whatsoever of a subscriber identity module, or a mobile communication terminal. Thus, Fig. 1 and its corresponding description are evidently not relevant.

In *Hussmann's* embodiment illustrated in Fig. 2, a GSM mobile telephone 201 which includes a subscriber identity module (SIM) is shown. The SIM is accessible for the CPU of the telephone. (*See paragraph [0034].*) The mobile telephone also includes an interface 204 between the telephone's CPU and a memory unit 203 of an RFID transponder 202 which is *integrated in the telephone.* (*See paragraph [0035].*)

The embodiments illustrated in Figs. 3a-3c appear to show similar structural features as demonstrated above.

Hussmann is distinguished from the claimed invention in that nowhere does *Hussmann* teach or suggest that an antenna is included in the SIM. On the contrary, *Hussmann's* RFID transponder is clearly illustrated in Figs. 2 and 3a as being arranged separately from the SIM. (*Emphasis added.*)

Moreover, since paragraph [0035] reads "*an RFID transponder 202 integrated into the telephone*", and paragraph [0034] reads "*a detachable subscriber unit, is inserted into the phone*", it is evident that *Hussmann* merely teaches arranging the transponder separately from the SIM.

Thus, it is respectfully submitted that *Hussmann* fails to teach or suggest a wireless communication device that is connected to *an antenna included in a subscriber identity module.*

Ritter has not been, and indeed cannot be, relied upon to fulfill the above-noted deficiency of *Hussmann*.

In both embodiments (Figs. 1 and 2) of *Ritter*, the communication between the SIM ("chip card") 2 and the outside device 3 makes use of an antenna 15 which is *integrated in the back of the housing 18* (cf. page 7, line 13) of the mobile apparatus 1. Further, as stated on page 7, lines 22-24, "the antenna is integrated in the housing in such a way that the absorption is kept as small as possible and that a transmission with the chosen frequency is also possible".

Thus, it is evident that *Ritter* does not teach an antenna included in the SIM.

At least in view of the above, Applicants respectfully submit that the asserted combination of *Hussmann* and *Ritter* (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of independent claims 1 and 18 or any claim depending therefrom.

Accordingly, Applicants respectfully request to withdraw the rejection of claims 1-10, 18, and 19, based on *Hussmann* and *Ritter*.

Unexamined dependent claims 11-17 are distinguishable from *Hussmann* and *Ritter* at least by virtue of their dependency on corresponding independent claim.

CONCLUSION

All rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali M. Imam Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/594,559
Amendment dated December 9, 2009
Reply to Office Action of July 27, 2009

Docket No.: 1380-0231PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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